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Docket No.: 2836-0160PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Anton Christian LAURIDSEN et al.

Application No.: 10/586,136

Confirmation No.: 3839

Filed: December 6, 2006

Art Unit: 2142

For: SYSTEM FOR HANDLING ELECTRONIC
MAIL IN A MULTIPLE USER
ENVIRONMENT

Examiner: Not Yet Assigned

LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Subsequent to the filing of the above-identified application on December 6, 2006, attached hereto is Form PCT/IB/326, Form PCT/IB/373 and Form PCT/IB/237 that should be made of record in the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or to credit any overpayment to Deposit Account No. 02-2448 for any

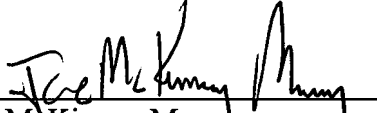
Application No.: 10/586,136

Docket No.: 2836-0160PUS1

additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Dated: May 1, 2007

Respectfully submitted,

By 
Joe McKinney Muncy
Registration No.: 32,334
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment(s)

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION CONCERNING
TRANSMITTAL OF COPY OF INTERNATIONAL
PRELIMINARY REPORT ON PATENTABILITY
(CHAPTER I OF THE PATENT COOPERATION
TREATY)

(PCT Rule 44bis.1(c))

To:

RECEIVED

16 MRS. 2007

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HOIBERG A/S
Store Kongensgade 59A
DK-1264 Copenhagen K
DANEMARK

Date of mailing (*day/month/year*)

08 March 2007 (08.03.2007)

Applicant's or agent's file reference

P 1271 PC00

IMPORTANT NOTICE

International application No.

PCT/DK2005/000555

International filing date (*day/month/year*)

31 August 2005 (31.08.2005)

Priority date (*day/month/year*)

31 August 2004 (31.08.2004)

Applicant

OPPORTUNITY SOLUTIONS A/S et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

Simin Baharlou

Facsimile No. +41 22 338 82 70

e-mail: pt09.pct@wipo.int

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference P 1271 PC00	FOR FURTHER ACTION	See item 4 below
International application No. PCT/DK2005/000555	International filing date (<i>day/month/year</i>) 31 August 2005 (31.08.2005)	Priority date (<i>day/month/year</i>) 31 August 2004 (31.08.2004)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant OPPORTUNITY SOLUTIONS A/S		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 9 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input checked="" type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input checked="" type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 28 February 2007 (28.02.2007)
Facsimile No. +41 22 338 82 70	Authorized officer <div style="text-align: center; font-weight: bold; margin-top: 10px;">Simin Baharlou</div> e-mail: pt09.pct@wipo.int

PATENT COOPERATION TREATY

REC'D 19 OCT 2005

WIPO

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From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/DK2005/000555

International filing date (day/month/year)
31.08.2005

Priority date (day/month/year)
31.08.2004

International Patent Classification (IPC) or both national classification and IPC
H04L12/58

Applicant
OPPORTUNITY SOLUTIONS AS

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0 Tx: 523656 epmu d
Fax: +49 89 2399 - 4465

Authorized Officer

Schrembs, G

Telephone No. +49 89 2399-5774



**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/DK2005/000555

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

Box No. II Priority

1. ☒ The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43*bis*.1 and 64.1) is the claimed priority date.
2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/DK2005/000555

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-29
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-29
Industrial applicability (IA)	Yes: Claims	1-29
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

Re Item V.

- 1 Reference is made to the following documents:

D1: US-B1-6 615 241 (ROSS LEWIS EDWARD ET AL) 2 September 2003 (2003-09-02)

D2: US 2003/061209 A1 (HYLAND-WOOD DAVID P ET AL) 27 March 2003 (2003-03-27)

- 2 The present application does not meet the criteria of Article 33(1) PCT, because the subject matter of **independent claims 1, 19 and 29**, as far as it can be understood (please refer to Re Item VIII), does not involve an inventive step in the sense of Article 33(3)PCT.

- 2.1 Document D1 (see in particular: abstract; column 1, lines 10-20; column 5, lines 13-38; column 6, line 45 - column 7, line 16, lines 36-47; column 8, lines 18-24; column 10, lines 24-46; column 11, lines 18-36; column 12, lines 40-65; column 13, line 65 - column 14, line 65; column 15, lines 4-56; column 16, lines 59-67; figures 1,4,9A,9F-H,10A-C), which is considered to represent the most relevant state of the art with respect to the subject-matter of **claim 1**, discloses (the references in parentheses applying to this document):

An electronic mail management system for handling electronic mail in a shared multiple user environment (abstract; column 1, lines 10-20; column 6, lines 45-58; figure 1), in which the user's incoming electronic mail are sent and received from external correspondents (column 6, lines 58-61), the system includes a common mail server with a central storage wherein electronic mail items of the users are stored and may be retrieved (column 6, line 62 - column 7, line 2; figure 1), the system comprising: detecting means for monitoring the flow of in- and outbound electronic mails on the mail server for a specified set of users and intercepting the in- and outbound e-mails (column 6, lines 62-64; column 7, lines 2-10; figures 1,4,9A,10A-C); journalising means for creating a notification record of a set of e-mail information data for each of the intercepted electronic mails (correspondent data and message objects: column 7, lines 13-16; column 8, lines 18-24; column 10, lines 24-33; column 11, lines 18-36; column 15, lines

4-53; figure 9H).

- 2.2 The subject matter of **claim 1** differs from the method of D1 in that notification records and associated electronic mails are stored in a relation database for user access by search query.
- 2.3 The problem to be solved by the present invention may therefore be regarded as how to store and provide access to electronic-mails.
- 2.4 However in seeking a solution to this problem, the skilled person would consider the disclosure of document D2 (see in particular: abstract; page 1, column 1, line 15 - page 2, column 1, line 12; page 2, column 2, line 15 - page 3, column 1, line 4; page 3, column 2, lines 1-17; page 4, column 1, line 33 - page 5, column 1, line 19; claims 1-4,13,17,20,22,29; figures 2-7A) dealing with a database query interface tool to e.g. search and review a database of electronic mail messages.

In particular D2 discloses an electronic mail manager database for storing the notification records and the associated electronic mails in a relation database so that the notification records and the associated electronic mails are accessible for the users in the multiple user environment by a search query (page 1, column 2, lines 5-7; page 1, column 2, lines 43-55; page 2, column 2, lines 33-38, lines 60-63; page 4, column 1, lines 33-67; claims 2-4,20); and means for establishing a journal of e-mails from the notification records in the electronic mail management database by defining a search request query and submitting the search request to a search engine for selecting a user-defined series of information data from the notification records in the electronic mail management database (page 1, column 2, lines 57 - page 2, column 1, line 12; page 3, column 2, lines 1-14; page 4, column 2, line 1 - page 5, column 1, line 22; claims 1,13,17,22,29).

In order to solve the above mentioned problem, the skilled person would apply these features to the disclosure of D1, thus arriving at the subject-matter of **claim 1** without exercise of inventive skill.

Therefore the subject-matter of **claim 1** does not involve an inventive step and does not satisfy the criterion set forth in Article 33(3) PCT.

- 2.5 The same objection of lack of inventive step also applies to **independent claims 19 resp. independent claim 29**, which relate to a method resp. a computer usable medium entirely corresponding to the apparatus defined by claim 1.
Claims 19 and 29 are thus also not allowable under Articles 33(3) PCT for the same reasons set out above with respect to claim 1.
- 3 **Dependent claims 2-18 and 20-28** do not contain any features, which in combination with the features of any claim to which they refer meet the requirements of the PCT in respect of inventive step (Article 33(3) PCT).
- 3.1 The features of **dependent claims 2, 3, 5-8, 11, 13, 17, 20-22, 24 and 27** are disclosed in document D1 (the references in parentheses applying to this document):
- Claims 2/20: "the detection means include means for formatting each intercepted electronic mail" (column 11, lines 18-36)
- Claims 3/21: "the detection means further include means for copying the formatted electronic mail to the electronic mail manager database" (column 13, line 65 - column 14, line 65)
- Claim 5: "the means for establishing a journal involves a search according to at least one selection criterion in the notification record for establishing a journal of e-mails" (column 5, lines 13-37)
- Claim 6: "the data in the notification record includes a notification message for each e-mail, the notification message containing e-mail header information including at least one of the following data: time of receipt; information concerning the sender; information concerning the recipient or recipient; information regarding copy recipients and/or blind copy recipients; message identification; reference data; subject; comments and keywords" (column 13, line 65 - column 15, line 53)
- Claim 7: "the electronic mail management system is adapted to cooperate with any SMTP protocol based e-mail systems" (column 1, line 64 - column 2, line 20; column 13, line 65 - column 14, line 9)
- Claim 8: "the specified set of users being subjected to the detection means is all users in the multiple user environment is at least two users" (column 6, lines 45-61; figure 1)

Claims 11/22: "the means for establishing a journal include an e-mail management dialog means for each user for indicating arrival and departure of e-mails" (column 13, lines 3-22)

Claims 13/24: "the dialog means provide for automatic journalising for each arriving and departing e-mail" (claims 10-11)

Claims 17/27: "the means for establishing a journal of e-mails is adapted for providing a multiple of journals" (column 15, lines 4-53)

Claims 2, 3, 5-8, 11, 13, 17, 20-22, 24 and 27 do not involve an inventive step in the sense of Article 33(3) PCT.

3.2 Furthermore the features of **dependent claims 18 and 28** are disclosed in document D2 (the references in parentheses applying to this document):

Claims 18/28: "a journal is established by comparing two or more of the multiple of journals by Boolean operators" (page 1, column 1, lines 45-47)

Claims 18 and 28 do not involve an inventive step in the sense of Article 33(3) PCT.

3.3 The features of **dependent claims 4, 9-10, 12, 14-16, 23 and 25-26** refer to further details (e.g. 'the relation database is hosted on a SQL server' or 'the acceptance criterion for journalising') of the e-mail management system resp. the method of journalising e-mail, which the skilled person would regard as a normal design option.

Claims 4, 9-10, 12, 14-17, 23 and 25-27 do not involve an inventive step in the sense of Article 33(3) PCT.

4 Industrial applicability is given in the field of electronic mail management (Article 33(4) PCT).

Re Item VII.

1 **Independent claims 1, 19 and 29** are not in the two-part form in accordance with Rule 6.3(b) PCT.

- 2 The features of the claims are not provided with reference signs (here from 10 to 74) placed in parentheses (Rule 6.2(b) PCT).

Re Item VIII.

- 1 The application does not meet the requirements of Article 6 PCT, because **claims 1, 3, 6, 7, 16, 18, 19, 21 and 29** are not clear.

- 1.1 The following abbreviations and terms placed in parentheses used in **independent claims 1, 19 and 29 and dependent claims 3, 6, 7 and 21** do not represent reference signs and thus may lead to a lack of clarity (Rule 6.2(b) PCT):

EMM DB:	claims 1, 3, 19, 21, 29
date:	claim 6
"from":	claim 6
"to":	claim 6
"cc":	claim 6
"bcc":	claim 6
EMM:	claim 7

- 1.2 The following typing errors should be corrected in **dependent claim 16**:

Incorrect:

A system according to claim 14

Correct:

A system according to claim 15

- 1.3 As explained in the following some of the features in **dependent apparatus claim 18** relate to a method of using the apparatus rather than clearly defining the apparatus in terms of its technical features. The intended limitations are therefore not clear from this claim contrary to the requirements of Article 6 PCT:

"a journal is established by comparing two or more of the multiple journals"